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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,980	09/10/2002	Vicente Javier Benedi Benito	84086	5781

24628 7590 10/26/2004

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EXAMINER

STRZELECKA, TERESA E

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,980	BENEDI BENITO ET AL.	
	Examiner	Art Unit	
	Teresa E Strzelecka	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 8-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>18102004</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This is a supplemental Restriction/Election Requirement which is being sent out because of a typographical error in claim numbering of Group I in the Election/Restriction Requirement mailed September 17, 2004.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 8-14, drawn to a special technical feature of a method for differentiating the seeds of the plant species of *Cyamopsis tetragonolobus* and *Ceratonic siliqua* from each other or other seeds based on their different rDNA, said method comprising the steps of:

- i) germinating seeds of a plant to form germinated seeds;
- ii) extracting DNA from the germinated seeds to form extracted DNA;
- iii) amplifying the extracted DNA using primers ITS2 (SEQ ID NO:4), ITS3 (SEQ ID NO:2), ITS4 (SEQ ID NO:3) and ITS5 (SEQ ID NO:1) to form rDNA amplification products; and
- iv) detecting the rDNA amplification products, thereby differentiating the seeds of the plant species of *Cyamopsis tetragonolobus* and *Ceratonic siliqua* from each other or other seeds.

Group II, claim(s) 15-17, drawn to a special technical feature of a method for specifically distinguishing guar seeds from other seeds, said method comprising the steps of:

- i) germinating seeds of a plant to form germinated seeds;
- ii) extracting DNA from the germinated seeds to form extracted DNA;
- iii) preparing guar-specific primers that are identical to a portion of guar plant sequence AJ1245577 (SEQ ID NO:9) or AJ245578 (SEQ ID NO:7) but different from portion of carob tree sequence A.1245575 (SEQ ID NO:8) or AJ245576 (SEQ ID NO:10) that aligns with the portion of guar plant sequence
- iv) amplifying the extracted DNA from step ii using the guar-specific primers from step iii to form rDNA amplification products; and
- v) detecting the rDNA amplification products, thereby specifically distinguishing guar seeds.

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Group III, claim(s) 18-26, drawn to a special technical feature of a method for obtaining extracted DNA from gum samples comprising one or more of guar gum (E 412) and locust bean gum (E 410), comprising the steps of:

- i) contacting a gum sample comprising DNA and one or more of guar gum (E412) and locust bean gum (E 410) with an aqueous solution to form an extraction mixture;
- ii) agitating the extraction mixture at a temperature between 0°C and 100°C for a time period sufficient to permit extraction of DNA from the gum sample into the aqueous solution;
- iii) separating the extraction mixture to obtain an aqueous solution containing extracted DNA and another phase; and
- iv) recovering a sample of the aqueous solution containing extracted DNA.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: these Groups are drawn to methods which have different special technical features. The special technical feature of Group I is differentiation of the seeds of plant species of *Cyamopsis tetragonolobus* and *Ceratonic siliqua* from each other or other seeds by amplification of DNA extracted from the seeds using primers with SEQ ID NO: 1-4, the special technical feature of Group II is differentiation of guar seeds from other seeds by amplification of DNA extracted from the seeds using guar-specific primers based on SEQ ID NO: 9 which do not match sequences of SEQ ID NO: 7, 8 or 10 which are identical to SEQ ID NO: 9, and the special technical feature of Group III is extraction of DNA from gum samples.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (571) 272-0789. The examiner can normally be reached on M-F (8:30-5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Teresa E Strzelecka
Teresa Strzelecka
Examiner
Art Unit 1637

October 18, 2004